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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,570	10/03/2000	Thomas J. Reid	55409USA3A.002	5623

7590

03/26/2002

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EXAMINER

GALLAGHER, JOHN J

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 03/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-4

# Office Action Summary

Application No.

09/678570

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-17 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-17 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
  - ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2-3
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☒ Other FOREIGN REFERENCE COPY

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1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There is <sup>APPARENTLY</sup> no support in the specification for a process which employs a COMBINATION of steps as set forth in steps (c) and (d) as recited in claim 17, the entire tenor of applicants' specification (N.B. page 2 line 29 thru page 3 line 2 and page 11 lines 14-15) apparently indicating that EITHER BUT NOT BOTH of the aforementioned steps is employed in any one process. Further, although this claim constitutes an original claim, it can apparently NOT be employed to establish a disclosure by bringing the specification into correspondence therewith, in that it is seen to be inaccurate and/or inoperative as presented i.e. if the wood substrate is treated as in the aforementioned step (c), then the wood SURFACE apparently cannot then be wetted as recited in step (d).

2. Claims 11-13 and 17 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Specifically (a) claims 11 and 13 line 2 of each - the term "(a)" should be deleted in that there is already a step "(a)" in claim 1; (b) claim 12 should apparently depend from claim 11 (for the sake of antecedent

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basis) and NOT from claim 8 as now presented; and (c) claim 17 - see paragraph 1, above.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 8 and 13-14 are rejected under 35 U.S.C. § 102(b) as being (clearly) anticipated by Hoogstoel.

Hoogstoel discloses that it is known to apply a repositionable PSA coated plastic film to a wood substrate via a process wherein a barrier and/or wetting liquid is applied to the substrate prior to the application of the adhesive coated film thereto. (Abstract, column 1 lines 19-41 and 66-75, column 2 lines 1-37). All of the essential limitations of these claims as presented are held to be satisfied by this reference.

5. Claims 11-12 are further rejected under 35 U.S.C. § 102(b) as being (clearly) anticipated by the Australian reference to Hlubucek et al.

Hlubucek et al. disclose a process of the type and most similar to that of Hoogstoel (the adhesive rubber lattice of these patentees being held to constitute a PSA) wherein the wood

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substrate may be coated with a resinous layer (carried and applied from either aqueous or solvent media) prior to the application of the adhesive coated film thereto. (Page 2 lines 1-11, page 2 line 18 thru page 3 line 15 and N.B. page 2 line 30 thru page 3 line 2). All of the essential limitations of these claims are held to be satisfied by this reference.

6. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-7 and 9-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hoogstoel. It would have been obvious to those of ordinary skill in this art to employ the specific (a) materials (viz. wood and plastic film); (b) thicknesses (of both adhesive and plastic film); and (c) UV absorber claimed, in the process of this patentee (if not already inherent therein) in place of the corresponding, analogous elements employed therein in that (a) this patentee is not limited with respect to either materials used or material thicknesses (which latter are held to be well within the purview

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of those of ordinary skill to determine and effect in order to achieve the desired result viz. adhesive bonding); and (b) the same result as is envisioned by applicants (again, adhesive bonding) is achieved by this patentee.

8. Claims 15-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hoogstoel in view of applicants' admission as to what constitutes prior art/the state of the art (hereinafter referred to as the prior art admission).

The prior art admission (N.B. page 9 lines 8-10 and page 9 line 23 thru page 10 line 14) establishes that the subject matter recited in these claims is known as conventional, such that it would have been obvious to one of ordinary skill in this art to make use of any or all of this conventional material in/in conjunction with the process of Hoogstoel, wherever deemed desirable and/or necessary.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. J. Gallagher whose telephone number is (703) 308-1971. The examiner can normally be reached on M-F from approximately 8:30 A.M. to 5 P.M. The examiner can also be reached on alternate N/A.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball, can be reached on (703) 308-2058. The fax phone number for this Group is (703) <sup>876-9310</sup>~~305-3599~~.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661/0662.

  
JJGallagher:cdc

March 12, 2002

  
**JOHN J. GALLAGHER**  
**PRIMARY EXAMINER**  
**ART UNIT 131 / 733**